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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,935	11/01/2001	Robert Eric Montgomery	3564	9955
25099	7590	11/10/2005	EXAMINER	
DAVID M QUINLAN, PC 32 NASSAU STREET SUITE 300 PRINCETON, NJ 08542			JAGOE, DONNA A	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,935	Applicant(s) MONTGOMERY, ROBERT ERIC	
	Examiner Donna Jagoe	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-65 and 67-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-65 and 67-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/2005</u> <u>9/17/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 56-65 and 67-75 are pending in this application.

Terminal Disclaimer

The terminal disclaimers filed on 11/2/04 and 7/21/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/050,196 and U.S. Patent Nos. 6,322,773 and 6,536,628 has been reviewed and is accepted. The terminal disclaimers have been recorded.

Response to Arguments

Applicant's arguments with respect to claims 56-65 and 67-75 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 56-65 and 67-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. U.S. Patent No. 3,739,947.

Baumann et al. teach a storing and mixing receptacle comprising chambers for a first and second ingredient, such as a dental product. (see abstract). The receptacle includes a first or mixing chamber for receiving a first, preferably pulverant ingredient and at least a second chamber for receiving a second ingredient, which may be liquid, pasty or solid at room temperature, and the second chamber is separated from the first chamber by separating means. To mix the ingredients with each other, pressure is at the start exerted upon the secondary or second piston, which limits the second chamber containing the normally liquid or pasty ingredients. A connection to the first chamber will thereby be established so that the liquid or pasty ingredient will be transferred to the first or mixing chamber. The contents will be mixed in the first chamber in a vibrating or oscillating mixer (see column 2, line 1 et seq.).

It does not teach the hydrogen peroxide tooth bleaching composition. It is noted that the reference does not teach that the dosage delivery unit to be used in the manner instantly claimed, however, the intended use of the claimed dosage delivery unit does not patentably distinguish the unit, per se, since such undisclosed use is inherent in the reference dosage delivery unit for delivering agents from separate chambers that are mixed in response to pressure applied. In order to be limiting, the intended use must

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create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). Thus it would have been obvious to deliver a tooth bleaching composition from a multi-chambered vessel with a static mixer motivated by the teaching of Baumann et al. that products that are capable of reacting with each other can be stored and mixed prior to use in a vessel with individual chambers of a mixing receptacle with a piston that mixes the contents prior to use (column 1, lines 46-64).

Claims 56-65 and 67-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuhas U.S. Patent No. 3,693,837.

Yuhas teaches an aerosol dispensing device for co-dispensing of contained separated materials through an actuated dispense system (col. 1, lines 1-10) for dispensing agents that are co-dispensed only at the point of actual dispensing. This would be useful for agents such as striped products, such as striped toothpaste (column

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1, lines 11-27). It does not teach the hydrogen peroxide tooth bleaching composition. It is noted that the reference does not teach that the dosage delivery unit to be used in the manner instantly claimed, however, the intended use of the claimed dosage delivery unit does not patentably distinguish the unit, per se, since such undisclosed use is inherent in the reference dosage delivery unit for delivering agents from separate chambers that are mixed in response to pressure applied. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). Thus it would have been obvious to deliver a tooth bleaching composition from a multi-chambered vessel with a static mixer motivated by the teaching of Baumann et al. that products that are capable of reacting with each other can be stored and mixed prior to use in a vessel with individual chambers of a

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mixing receptacle with a piston that mixes the contents prior to use (column 1, lines 46-64).

Thus the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Accordingly, for the above reasons, the claims are deemed properly rejected and none are allowed.

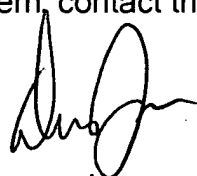
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donna Jagoe
Patent Examiner
Art Unit 1614

10/17/2005



THURMAN K. PAGE, M.A., J.D.
SUPERVISORY PATENT EXAMINER